

REMARKS

By this amendment, claim 21 has been amended. This amendment is made to even more clearly recite the claimed invention, does not add prohibited new matter and is fully supported by the specification (*see, e.g.* page 13 of the present specification). Reconsideration and withdrawal of the rejections set forth in the outstanding Office Action are respectfully requested in view of the foregoing amendments and the following remarks.

Information Disclosure Statements

Applicants note that the Examiner has lined through one of the publications listed in the PTO-1449 Form for the Information Disclosure Statements dated June 30, 2006 (Gurskaya et al., FEBS Letters, Vol. 507, pp. 16-20 (2001)). In response, Applicants note that a copy of this publication was submitted along with the Information Disclosure Statement dated June 30, 2006, and can be accessed on the Patent Application Information Retrieval (PAIR) system. Accordingly, Applicants submit herewith a new PTO-1449 Form, and respectfully request that the Examiner acknowledge consideration of this document by initialing the corresponding entry.

Rejections under 35 U.S.C. § 101

The Office Action rejects claims 21, 25, 26, and 31, asserting that these claims are directed to non-statutory subject matter, alleging that the claims read on wild type fluorescent proteins from sea anemones, which are products of nature and are therefore unpatentable. In response, without agreeing with or acquiescing to the rejection, Applicants note that claim 21 has been amended to recite "isolated DNA." Applicants respectfully request withdrawal of the rejections.

Rejections under 35 U.S.C. § 102(a)

The Office Action rejects claims 21, 25, and 26 under 35 U.S.C. § 102(a) as being anticipated by Ando et al. (PNAS USA, Vol. 99, pp. 12651-56, September 23, 2002, hereinafter “ANDO”). In response, Applicants submit herewith a Supplemental Claim of Priority including a verified English-language translation of JP Application No. 2002-274266 (filed September 20, 2002) in order to perfect priority to this document. Accordingly, Applicants invite the Examiner to review the priority document for its effect on the rejection.

Rejections under 35 U.S.C. § 102(e)

The Office Action rejects claims 21, 25, 26, and 31 under 35 U.S.C. 102(e) as being anticipated by Falkowski et al. (U.S. Patent No. 6,933,375, hereinafter “FALKOWSKI”). Although the sequences disclosed in FALKOWSKI match only 66.2% of the 225 amino acids in SEQ ID NO. 5, the Examiner suggests that the claims encompass a fluorescent protein with any number of deletions, substitutions, or additions of amino acids in the claimed sequences.

Without agreeing with or acquiescing to the rejection, Applicants note that the claims have been amended to recite “deletion, substitution and/or addition of one to twenty amino acids” and “deletion, substitution and/or addition of one to sixty nucleotides” to the claimed sequences (as described on page 13 of the specification). In view of these amendments, Applicants submit that FALKOWSKI does not disclose the claimed sequence, and, accordingly, FALKOWSKI fails to disclose all of the elements of the claimed invention. Thus, Applicants respectfully request withdrawal of the rejections.

Rejections for Obviousness-type Double Patenting

The Office Action rejects claim 21 on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 5 and 8 of Miyawaki et al. (U.S. Patent Application No. 10/581,551) and claims 17-19 of Miyawaki et al. (U.S. Patent Application No. 10/561,041).

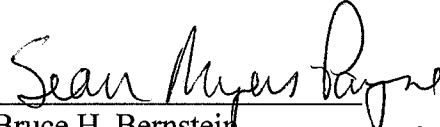
In light of the amendments discussed above, Applicants submit that the claims of the '551 application and the '041 application do not recite the claimed sequences. Accordingly, Applicants submit that the claimed invention is patentably distinct from the claims in the '551 application and the '041 application, and respectfully request withdrawal of the rejections.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue.

Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089. Should the Examiner have any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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